



Docket No. 1293.1125

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Byung-in MA, et al.

Serial No. 09/613,695

Group Art Unit: 2652

Confirmation No. 9690

Filed: July 10, 2000

Examiner: Wayne R Young

For: METHOD AND APPARATUS FOR TRACKING ERROR DETECTION IN OPTICAL DISK DRIVER

RESPONSE TO RESTRICTION REQUIREMENT

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Technology Center 2600

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed October 8, 2003, having a shortened period for response set to expire on November 10, 2003, November 8 being a Saturday. The following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Species A, which is drawn to the apparatus and method shown in FIGs. 3 through 4F in response to the preliminary restriction requirement set forth in the Office Action. As such, applicants elect claims 1-7, 10, and 12-21, which are generic or drawn to Species A as defined by the Examiner.

Moreover, the Examiner asserts on page 2 of the Office Action that that no claims are considered generic. However, it is respectfully submitted that at least claim 10 is generic to the Species A through D in that claim 10 does not specify a type of optical detection unit as in Species A through D, to the use or nonuse of a phase loop lock, and/or to the use or nonuse of a matrix circuit. As such, it is respectfully requested that at least claim 10 is generic for the claims in Species A through D, and is at least generic to claim 11 which depends there from.

II. Applicants Traverse the Requirement

On page 2 of the Office Action, the Examiner asserts that an election between Species A through D is required, but does not provide evidence as to why such a division need be made. Specifically, the Examiner has not provided evidence that the Examiner will experience an

undue burden in searching and examining the invention set forth in Species A through D. Specifically, the Examiner has not provided evidence that the existence of the four species represents an unreasonable number of species to be searched, and has not provided a rationale as to why the invention is to be separated into Species A through D. In contrast and consistent with the requirements in MPEP 803 and 808, the Examiner needs to provide a rationale as to why an election is required or how, without the election, the Examiner is unduly burdened in comparison with the burden visited on the applicants in the extra delay and expense in obtaining protection for each Species.

Further, there is no evidence on page 2 of the Office Action that the Examiner has considered the factors set forth in the guidance in MPEP 803. As such, it is respectfully submitted that the Examiner has not presented sufficient evidence of a burden on the Examiner in examining Species A through D which is out of proportion with the delay and expense visited on the applicants in protecting the invention of Species B through D so as to show an undue burden on the Examiner so as to also require an election between these species

III. Conclusion


Upon review of references involved in this field of technology, when considering that the apparatus and method recited by the Species A claims as compared to the apparatus and method claims of Species B through D, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial election requirement, all of the pending claims should be examined in the subject application.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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